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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,373	11/09/2001	Marguerite B. McDonald	55915 79422	1045
44777	7590	07/20/2005	EXAMINER	
W. EDWARD RAMAGE COMMERCE CENTER SUITE 1000 211 COMMERCE ST NASHVILLE, TN 37201			THALER, MICHAEL H	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 07/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/014,373

Applicant(s)

MCDONALD, MARGUERITE B.

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-35 and 39-44 is/are pending in the application.
- 4a) Of the above claim(s) 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28,29,31-35 and 39-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

This application contains claim 30 drawn to an invention nonelected with traverse in the reply filed on June 21, 2004. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claims 28, 29, 31-35 and 39-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no basis in the original disclosure for the limitation in claim 28 that the side which includes the apertures is a "leading" side.

Claims 28, 31, 32, 34, 35, 42 and 43 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yaacobi et al. (6,413,245). Yaacobi et al. disclose connecting end 56, spatula-like member 52, 54 including an arcuate distal section 52, a side (e.g. the side shown in figure 3C which faces the top of the page, noting col. 4, lines 55-57) having a plurality of apertures (described in col. 4, lines 57-58 and shown in figure 3C, for example). This side is inherently a "leading side" since the device may

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inherently be moved such that this side precedes the other sides during movement. Alternatively, it would have been obvious that this side is a "leading side" since the device may be moved such that this side precedes the other sides during movement. The Yaacobi et al. instrument is inherently capable of ejecting fluid onto the cornea. As to claim 34, note col. 5, lines 39-40. As to claims 35 and 42, note col. 5, lines 66-67. As to claim 43, note col. 5, lines 52-53.

Claims 33 and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yaacobi et al. (6,413,245). Yaacobi et al. fail to disclose the specific claimed dimensions and number of apertures. However, Yaacobi et al. disclose that dimensions and number of apertures other than those which are listed may be used (col. 4, lines 61-62 and 64-66 and col. 8, lines 16-19). It would have been obvious to use the specific claimed dimensions and number of apertures in the Yaacobi et al. instrument for this reason.

Claims 29 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yaacobi et al. (6,413,245) in view of Doshi et al. (6,443,944). Yaacobi et al. disclose the spatula-like member as having a circular rather than a trapezoidal cross-sectional shape as claimed. However, Doshi et al. teach that the tubular member of a surgical instrument may have a

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trapezoidal rather than a circular cross-sectional shape (col. 6, lines 47-52) apparently since each shape would work equally well. It would have been obvious to make the cross-sectional shape of the Yaacobi et al. instrument trapezoidal rather than a circular for this reason.

Applicant's arguments filed Dec. 27, 2004 have been fully considered but they are not persuasive for the reasons set forth above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael

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Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

mht
7/18/05



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731